

REMARKS

Claims 1-10 were pending in the application. Applicants have not included a listing of the claims, as no claims amendments have been made. Upon entry of the present response, claims 1-10 will be pending.

THE CLAIM REJECTIONS SHOULD BE WITHDRAWN

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over United States Patent No. 5,670,051 to Pinnau *et al.* taken together with United States Patent No. 6,706,771 to Kim *et al.* (“the Kim ’771 patent”). The Office Action states that the rejection may be overcome by showing that the reference is disqualified under 35 USC 103(c) as prior art in a rejection under 35 USC § 103(a). *See* MPEP §§ 706.02 (I)(1) and 706.02 (I)(2). In addition, according to MPEP § 706.02 (I)(2):

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

Applicants points out that both the present application and the Kim ’771 patent are commonly owned by the Korea Institute of Science and Technology. The assignment of the Kim ’771 patent is recorded at Reel 013097, Frame 0975, while the assignment of the present application is recorded at Reel 015207, Frame 0635. Furthermore, Applicants state that the subject matter of both the present application and the Kim ’771 patent were, at the time the invention disclosed in the present application was made, commonly owned by, or subject to an obligation of assignment to the Korea Institute of Science and Technology. As the Kim ’771 patent qualifies as prior art only, if at all, as being available as art under 35 U.S.C. § 102(e), the common ownership is sufficient to disqualify the Kim ’771 patent as prior art in the 35 U.S.C. § 103 rejection. *See, e.g.*, 35 U.S.C. § 103(c) and MPEP § 706.02 (I)(1) and § 706.02 (I)(2). Therefore, the Kim ’771 patent is not prior art, and for this reason

alone the rejection under 35 U.S.C. § 103(a) over Pinnau *et al.* taken together with Kim *et al.* should be withdrawn.¹

¹ Applicant reserves the right to present further arguments demonstrating the differences between the claimed invention and the Kim '771 patent. However, in view of the fact that the Kim '771 patent does not qualify as prior art, this rejection must be withdrawn.

CONCLUSION

Applicants respectfully request that the foregoing amendments and remarks be made of record in the file of the above-identified application. Applicants believe that the application is now in condition of allowance. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

No fee is believed to be due for this submission. Should any fees be required, however, please charge such fees to Jones Day Deposit Account No. 50-3013. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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